

RESPONSE under 37 C.F.R. § 1.111
U.S. Appl. No. 09/773,682

REMARKS

Claims 53-72 are all the claims pending in the application and stand rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks.

CLAIM REJECTIONS.

35 U.S.C. § 102 and 103

Claims 53-72 are rejected under 35 U.S.C. § 102(e) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as being unpatentable over, U.S. Patent Application 2002/0049806 to Gatz et al. (hereinafter Gatz). Applicant respectfully traverses these rejections for the following reasons.

Gatz has an effective priority date of May 16, 2000 (U.S. Provisional Application 60/204,910). Applicant however conceived and diligently reduced to practice the invention of the instant application prior to the Gatz priority date as demonstrated by the inventor declaration under 37 C.F.R. § 1.131 previously submitted. Accordingly, Applicant believes Gatz is not considered prior art within the meaning of 35 U.S.C. § 102 and thus the §102 and §103 rejections relying on Gatz should be withdrawn. In the 4/21/06 Office Action, it is alleged that Applicant's previous declaration does not support Applicant's claim of priority because (i) the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Gatz reference; and (ii) the evidence submitted is insufficient to establish diligence from conception to constructive or actual reduction to practice. Applicant respectfully disagrees.

It is respectfully submitted that the Invention Disclosure form of "the attached Exhibit" to the Declaration discloses conception including full details of preferred embodiments for the invention claimed in pending claims 53-72. There is not simply only a "vague idea" as asserted

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on page 3 of the 4/21/06 Office Action. Instead, Applicant submits that the details set forth in the invention disclosure is more than sufficient for a skilled artisan to make and use the invention in all of Applicant's present claims without additional invention. It is well established that if the complete formation in the mind of an inventor of a definite and permanent idea for a complete and operative invention as it would be applied in practice is shown; conception of an invention is indisputably established. *Townsend v. Smith*, 36 F.2d 292, 295 (CCPA 1930). Conception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill. *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). The Office Action has not even attempted to explain why Applicant's claims are not fully described in the exhibit but rather summarily states only that "it shows a vague idea." Respectfully, Applicant submits that that the Office Action has failed to give full and proper consideration of Applicant's evidence as required by Office policy and established precedent.

With respect to establishing diligence from its date of conception, Applicant respectfully submits that the inventor's declaration makes clear that the inventor diligently pursued the invention by "working with other Intel engineers to reduce the conceived invention into practice for an Intel Wireless Series Product line as well as working with attorneys in preparing and filing the patent application" in accordance with normal and customary Intel business practices. Notwithstanding, Applicant is in the process of explaining in greater detail in a new 1.131 declaration the process of reduction of this invention into practice. The new declaration will shortly follow this response.

With respect to the actual teachings of the Gatz reference, Applicant respectfully submits that even disregarding the fact that Applicant's invention predates Gatz, Gatz in fact does not teach or suggest Applicant's claimed invention as alleged by in the Office Action.

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Gatz discloses a parental control system for use in account-based Internet access server. (See Title). Gatz discloses an invention to provide an account-based access control system which allows the holder of once Internet account to control the ability of other account holders to access information in an information network via an access server. (Par. [0014]). To this end, Gatz discloses the use of a data network 1 (Fig. 1) which includes an on-line account-based access server 2 (Par. [0038]), and information content servers 4, 6 which provide information content to users of the network 1 (e.g., client devices 8 and 10). Par. [0042].

By using the account control system, one or more parents can control the access to Internet resources and settings of the user of a child account. For example, the parent can grant permission for the child to use the online services provided with the child account, control the information the child shares with others using the online services and can maintain and monitor the child account on an ongoing bases. Par. [0058].

In contrast, Applicant's claim 53 recites: *An apparatus comprising: a wireless communication device having a restricted list of contacts wherein the wireless communication device is limited to communicate with only the contacts associated with the restricted list, and wherein the restricted contact list is determined by an administrator and set by a different device.*

While Gatz suggests parental control of access to Internet resources, it does not teach or suggest: a wireless communication device having a restricted list of contacts for which communication of the wireless communication device is limited as recited in Applicant's claim 53.

The Office Action cites paragraph [0039] of Gatz as disclosing a wireless device. Respectfully, this portion of Gatz discloses only that portions of data network 1 may communicate via wireless links. The skilled artisan would readily recognize that Gatz access server 2, which the Office Action alleges includes a restricted list, is not a wireless communication device. While Gatz paragraph [0051] does mention that a client device could

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include a wireless telephone, there is no teaching or suggestion that the wireless telephone could or should include a list of restricted contacts to which the wireless telephone is limited to communicate. In fact, Gatz teaches away from Applicant's claimed limitations by teaching throughout, that it is a centralized network based access server 2 that is used to restrict access to Internet resources.

Further, Gatz access server 2 limiting access of a user account from a general type or even specific Internet resources (e.g., restricting the child account's access with respect to email block lists or the child's "buddy list" of its messenger list, Par. [0074]) is not analogous to limiting a wireless communication device to communicate with only the contacts associated with a restricted list.

Applicant's independent claims 63 and 69 are similar to claim 53. For example, claim 63 recites: *An article of manufacture comprising a tangible medium storing machine readable instructions which cause a processor-based system to: maintain a restricted list of contacts; and enable a wireless device to communicate over a communication media only with contacts on the restricted list.*

And claim 69 recites: *A wireless system comprising: a wireless communication device; a base station to facilitate wireless communications between the wireless communication device and a core network; and a restricted list of contacts stored in at least one of the wireless communication device or the base station, wherein the system is adapted to restrict a user of the handheld device to communicate via the core network only with those contacts identified by the restricted list.*

Again, while Gatz network 1 may limit access to certain types of web sites, services or other Internet resources, Applicant respectfully submits that it fails to teach or suggest *enabling a wireless device to communicate only with a restricted list of contacts*. Gatz also fails to teach or suggest the base station recited in claim 69 in which the restricted list of contacts may be stored.

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With respect to the §103 rejection of claims 58-60 and 72, the Office Action expressly admits that Gatz does not disclose the limitations present in these claims. Instead, the Office Action relies on the knowledge of "one skilled in the art." Applicant respectfully requests that it is well settled that *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

Since admittedly Gatz fails to teach or suggest the specific limitations present in Applicant's claims, the rejection of claims 58-60 and 72 under 35 U.S.C. § 103 is improper and must be withdrawn.

In fact, Gatz teaches an invention in direct contrast of Applicant's claims where a centralized network access server, as opposed to a wireless device, a base station or a wireless router having a restricted contact list. In view of the foregoing, reconsideration and withdrawal of the §102 and §103 rejections based on Gatz are respectfully requested.

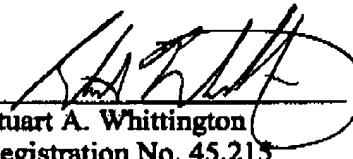
CONCLUSION.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to Deposit Account # 50-0221.

Respectfully submitted,



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